

REMARKS

Restriction Requirement and Species Election

In the Restriction Requirement that was mailed in this case on March 11, 2003, the Examiner required Applicants to elect one of the following six groups of claims:

I. Claims 1-8, drawn to fusion protein comprising (a) a ligand-binding domain, (b) a domain that associates when a ligand binds to the domain of (a), and (c) a domain comprising a cytokine receptor or part thereof that imparts proliferation activity to a cell upon association, DNA encoding the fusion protein, a vector comprising said DNA and cell comprising said vector, classified in class 536, subclass 23.4.

II. Claim 9, drawn to a method for selectively proliferating the cell of claim 8, classified in class 435, subclass 7.21.

III. Claims 10-18, drawn to a vector comprising a desired exogenous gene and a gene encoding a fusion protein comprising (a) a ligand-binding domain, (b) a domain that associates when a ligand binds to the domain of (a), and (c) a domain that imparts proliferation activity to a cell upon association and cell comprising said vector, classified in class 435, subclass 320.1.

IV. Claim 19, drawn to a method for selectively proliferating the cell of claim 18, classified in class 435, subclass 7.21, for example.

V. Claim 20, drawn to a kit comprising (a) vector of claim 7 and (b) a ligand capable of acting on the “ligand-binding domain” of the fusion protein encoded by the gene contained in the vector, ligand has not been specified, classified in 530, subclass 300.

VI. Claim 20, drawn to a kit comprising (a) vector of claim 10, and (b) a ligand capable of acting on the “ligand-binding domain” of the fusion protein encoded by the gene contained in the vector, ligand has not been specified, classified in 530, subclass 300.

The Examiner alleges that the instant application contains claims directed to the following patentably distinct species: G-CSF and c-mpl. The Examiner further alleges that claim 1 is generic.

Election

Applicants provisionally elect the invention of Group I, claims 1-8, with traverse. Applicants further elect, as a species, c-mpl, without traverse.

Request for Reconsideration

Applicants submit that Groups I, III, V, and VI should be examined together.

In support of the above claim division, the Examiner contends that the products of Inventions I (fusion protein), III (vector), V (kit 1), and VI (kit 2) are patentably distinct from each other because “they have distinct functional, chemical, and physical properties and are capable of separate uses and manufacture.” This is incorrect. These groups are

not independent and distinct. Each is related and restriction is improper.

First, Groups I and III, the fusion protein of claims 1-8 and the vector of claims 10-18 are related as subcombination and combination. According to MPEP 806.05(c), “where the relationship between claims is such that the separately claimed subcombination (B_{specific}) constitutes the essential distinguishing feature of the combination (Ab_{specific}) as claimed, the inventions are not distinct and **a requirement for restriction must not be made**, even though the subcombination has separate utility (emphasis added).” All the limitations of the subcombination claim (i.e., fusion protein of claim 1) are reiterated in the combination claim (i.e., the vector of claim 10).

Therefore, restriction between Groups I and III is improper.

Similar logic applies to Groups III, V, and VI. All the limitations of the subcombination claims (i.e., vector of claim 7 or claim 10) are reiterated in the combination claim (i.e., the kit of claim 20). Therefore, restriction between Groups III, V, and VI is also improper.

To reiterate, Applicants provisionally elect Group I, **with traverse**, arguing that all the product claims (claims 1-8, 10-18, and 20) should be examined together for the reasons set forth above.

Amendment

Claim 10 has been amended to recite “DNA” instead of “gene”; the language of combination claim 10 is now identical to that of subcombination claim 6. No new matter is added by this amendment.

CONCLUSION

Applicant respectfully requests reconsideration of the requirement for restriction. Enclosed is a Petition to extend the period for replying to the Restriction Requirement for three months, to and including July 11, 2003. Also enclosed is a check in payment of the required extension fee. If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

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